IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):   David Griffith

Title: ACTUARY-MANIPULABLE RATING MODEL AND SYSTEM

Application No.: 09/775,019   Filed: February 1, 2001

Examiner: Pass, Natalie   Group Art Unit: 3626

Atty. Docket No.: 027-0001   Confirmation No.:   7486

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P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In accordance with 1296 OG 67, Applicant respectfully requests review of the *final* rejection mailed on March 2, 2006.

REMARKS

Claims 3–15 and 19–24 are finally rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Publication No. 2002/0046064, naming Maury et al. (hereinafter *"Maury"*). Those rejections are not sustainable on appeal and this request seeks pre-appeal brief review and withdrawal. For reference, a current listing of the rejected claims appears in Applicant's *Response to Non-Final Action*, filed September 23, 2005, and the conferees are respectfully directed thereto.

Due to limitations of the pre-appeal brief conference process, we emphasize two (2) clear errors that require withdrawal of the present rejections, and focus on particular exemplary claims. Applicant's positions on appeal will be briefed more completely should that be necessary. We now turn to two specific errors:

1. ***ERROR 1:*** *Maury* simply does not disclose that which the Office attributes to it. Accordingly, no *prima facie* case of obviousness exists.

2. ***ERROR 2:*** Even if *Maury* did disclose that which the Office attributes to it, *Maury* is *not prior* to Applicant's filing date. Because certain elements of the *Maury* disclosure relied upon by the Office in its rejection of claims *do not appear* in the provisional application to which *Maury* claims priority, *Maury's* effective date as a reference against Applicants claims is no earlier than May 18, 2001 (over 4 months *after* Applicant's filing date). Because *Maury* is not "prior," no *prima facie* case of obviousness exists.

Maury Does Not Disclose that which Examiner Attributes to Maury

Maury discloses a system and method for furnishing an on-line quote for an insurance product. Although Applicant's claims recite methods, computer program products and apparatus that may be useful in a practical implementation of an on-line insurance rate quoting system, *Maury* simply does not disclose that which Applicants claim and, with all due respect, mere similarity of technical field does not an obviousness rejection make.

Three examples demonstrate the pattern of unsustainable rejections advanced by the Office without regard to the actual content of the relied upon reference.

Claim 10 recites a method of preparing an executable representation of a rating model and recites specific steps beginning with the definition of an "actuary manipulable representation of a rating model" and continues with a transformation of the actuary manipulable representation into an executable representation. As a preliminary matter, *Maury* does not teach *any* transformation from actuary manipulable form to executable form, let alone the representations and transformations claimed. That, by itself, is determinative and the rejections should be withdrawn for at least this reason.

In the final action,[1] the Office's rejection of claim 10 asserts that paragraphs [0030]-[0034] and [0037]-[0039] disclose:

> A **method of preparing an executable representation of a rating model**, the method comprising:
>> **defining** an actuary-manipulable representation of a rating model, the **actuary-manipulable representation including variables, factor tables and calculation sequences of the rating model, the factor tables having one or more axes bound to respective ones of the variables and the calculation sequences defined in terms of steps operative on values of the variables and cells of the factor tables;**
>> **transforming** the actuary-manipulable representation to the executable representation, the **executable representation including a runtime lookup facility for identification of runtime identifiers in the executable representation corresponding to ones of the variables and a calculate method executable to generate a quote based on inputs supplied via a predefined input interface.**

Applicants respectfully disagree and direct the conferees to the relied upon sections of *Maury*.

The relied upon sections (together with the remainder of *Maury*) disclose a networked information system for furnishing on-line quotes for insurance products. With all due respect, such disclosure is beside the point. Rejections are based on claims and relative to Applicant's claims, *Maury* does <u>not</u> disclose *transformation* of an actuary manipulable representation of a rating model into an executable representation, let alone a transformation of a rating model

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[1] In the final Office action dated March 2, 2006, the Office incorporates rejections of the preceding non-final Office action, dated June 29, 2005, and maintains rejections "for the same reasons given in the previous Office Action." Final action, page 3.

represented in the *actuary manipulable form claimed* to the *executable form claimed*. No *prima facie* case exists and, for this reason alone, the present rejection must be withdrawn.

The Office goes on to rationalize the rejection despite the acknowledged absence in *Maury* of "`factor tables having one or more axes`."[2] In the final rejection, the Office bases its rejection on "features well known in the art" and on disclosure (in *Maury* at [0035]) of use of a DTP communication protocol/interface for transporting data, presumably in the course quoting against rates of multiple insurance companies. Even cursory review by the conferees will confirm that the relied upon disclosure has nothing at all to do with the claimed limitation of an actuary-manipulable representation of a rating model including variables, factor tables and calculation sequences ..., the "`factor tables having one or more axes bound to respective ones of the variables and the calculation sequences defined in terms of steps operative on values of the variables and cells of the factor tables.`" If the claim limitation is "well known in the art" as it pertains to an actuary manipulable representation of a rating model suitable for transformation (as claimed) into an executable form, Applicants request that the Office *provide evidence* to support its assertion. Because the actuary manipulable representation of a rating model recited in claim 10 is not disclosed in *Maury* and no evidence exists that it is "well known in the art," there is no *prima facie* of obviousness and the rejection should be withdrawn for this reason as well.

Finally, the Office's reliance on the background of Applicant's specification is misplaced. While insurance companies will typically have a rating model for each line of insurance they offer, nothing in Applicant's disclosure or any art of record supports the Office's apparent conclusion that an *actuary-manipulable representation* of a rating model, including variables, factor tables and calculation sequences functionally interrelated as claimed, appears in the prior art or is transformed to executable form.

Claim 11 adds specific detail regarding the transformations performed for particular calculation sequences. No similar disclosure appears in *Maury* and the "corresponding disclosure" identified by the Office is pure fiction. Applicant's respectfully direct the conferees to paragraphs [0028], [0034] and [0041] relied upon by the examiner in the final rejection. Even a cursory review will confirm that *Maury* does not disclose or suggest that, for a particular calculation sequence of the actuary-manipulable representation, the "`transforming` [from actuary-manipulable representation to the executable representation] `includes`:

> `decomposing the particular calculation sequence into layers, each layer including those steps thereof that are at a same flow control level;`
> `for each layer, traversing the steps thereof to identify those of the variables used by the layer;`
> `for each layer, traversing the calculation sequence to identify the steps of the layer targeted by other steps of the calculation sequence and emitting code allocating storage for results of the targeted steps; and`
> `for each layer, emitting code for variable test and index calculations of the layer.`

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[2]   Applicants note that Examiner's truncation of the actual claim limitation is a bit misleading. The actual limitation reads: "`factor tables having one or more axes bound to respective ones of the variables and the calculation sequences defined in terms of steps operative on values of the variables and cells of the factor tables.`"

No *prima facie* case exists and the rejection must be withdrawn.

Claim 13 adds a specific two-step compilation process found nowhere in *Maury*. No similar disclosure appears in *Maury* and the "corresponding disclosure" identified by the Office is again inapplicable. Applicant's respectfully direct the conferees to paragraphs [0024] and [0031] relied upon by the examiner in the final rejection. Even a cursory review will confirm that *Maury* does not disclose or suggest that the "transforming [from actuary-manipulable representation to the executable representation] includes:

> ... a two-step compilation,
> a first step thereof producing a platform independent source form
>   from the actuary-manipulable representation, and
> a second step thereof producing the executable representation
>   from the platform independent source form.

Although the Office's reasoning is not entirely clear, it would appear that Office believes that use of Java™ technology in an on-line auto rate quoting system, renders claim 13 obvious. With all due respect, use of Cold Fusion, Java™, C, C++, HTML and JavaScript in the code of a networked system is a far cry from the specific two-step compilation process recited in Applicant's claim. No *prima facie* case exists and the rejection must be withdrawn.

Independent **claim 22** has been rejected for the same reasons as claim 10. Similarly, independent **claim 19** has been rejected for the same reasons as claim 10. Claims 19-23 are allowable for at least the reasons given above with respect to claim 10.

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Maury is NOT Prior

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Notwithstanding the substantive defects of the obviousness rejections, Applicant respectfully points out that the applied reference is simply *not prior* to Applicant's filing date. *Maury* constitutes a reference, if at all, under 35 U.S.C. § 102(e)(2) and application no. 09/860,679, which published as the *Maury* reference, was filed May 18, 2001 (over 4 months *after* Applicant's application). Although *Maury* claims priority to provisional application no. 60/206,007, filed May 19, 2000, the disclosure of the provisional application and that of the relied upon *Maury* publication **differ greatly**. Those differences are apparent on the face of the record and are material to *Maury's* effective date as a reference against Applicant's claims.

While it is not clear whether the Examiner has *simply presumed* that recitation of a claim of priority under 35 U.S.C. § 119(e) magically affords the Office with a new 102(e) date, it is clear that specific elements of Applicant's claims are nowhere to be found in provisional application no. 60/206,007. To complete the record for appellate review, Applicant obtained a copy of provisional application no. 60/206,007 and submitted same in an IDS filed September 23, 2005.

Applicants wish to emphasize for the Office, and in particular for the conferees, that neither recitation of a claim of priority, nor mere subject matter relationship between the relied upon disclosure (of *Maury*) and the content of provisional application no. 60/206,007, is sufficient to afford *Maury* with *an earlier effective date as a prior art reference*. Indeed, to support the Office's theory of obviousness, specific disclosure sufficient to reject Applicant's claims must be found in **both** (i) the *Maury* publication **and** (ii) the disclosure content of provisional application no. 60/206,007. As a matter of law, disclosure appearing in the *Maury*

publication, but not in the express or inherent disclosure of provisional application no. 60/206,007 cannot support the Office's theory of obviousness.

Applicants have advised the Office of the inadequacy of provisional application no. 60/206,007 to support the Office's theory of obviousness . In response, the Office has responded (*see* Advisory Action) with generalities regarding alleged correspondence between relied upon passages of *Maury* and flow charts of the provisional application. Specifically, the Office alleges that Figure 6; Attachment A, pages 8-14; Attachment B, pages 6-7 and Attachments F and G of provisional application no. 60/206,007 support an earlier effective date.
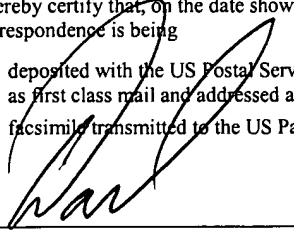
With all due respect, the alleged correspondence has nothing at all to do with Applicant's claimed subject matter. *No transformation from an actuary manipulable representation to an executable representation of a rating model appears in the sections identified by the Office or elsewhere in provisional application no. 60/206,007.* For purposes of the present prosecution, it is simply not relevant whether *some* disclosure of the *Maury* reference appears in the provisional application. What is relevant is whether specific disclosure sufficient to render Applicant's claims obvious appears in the provisional application.

The answer to that question is an emphatic NO! Applicants respectfully direct the conferees to the provisional application, and in particular to those portions of the provisional application which the Office alleges support the present obviousness rejections. Even a cursory review will confirm that no sustainable legal basis exists for affording *Maury* reference an earlier effective reference date *with respect to the subject matter recited in Applicant's claims.*

Accordingly, since the *Maury* reference cannot be accorded the date of provisional application no. 60/206,007 for the subject matter recited in Applicant's claims, the *Maury* reference is *not prior* and no *prima facie* case of obviousness exists for any of the claims.

Conclusion

The present rejections should be withdrawn for either or both of the reasons given above, *Maury* simply does not disclose that which the Office attributes to it. Accordingly, no *prima facie* case of obviousness exists. In addition, because *Maury* is not "prior," no *prima facie* case of obviousness exists. *Applicants respectfully request that the conferees direct withdrawal of all rejections and direct that the application be allowed forthwith.*

Respectfully submitted,

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